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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,876	03/08/2004	James Wesolek	13721	2879

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ORUM & ROTH  
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CHICAGO, IL 60604

EXAMINER

HAWK, NOAH CHANDLER

ART UNIT	PAPER NUMBER
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3636

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/796,876	WESOLEK, JAMES	
	<b>Examiner</b>	<b>Art Unit</b>	
	Noah C. Hawk	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/8/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 3/8/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7, 8, 10, 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. Regarding Claim 7, the phrase "and combinations thereof" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and combinations thereof"), thereby rendering the scope of the claim(s) unascertainable. Further, it is unclear if the applicant intends to recite wood and metal as two options for the material or if the applicant intends to introduce a new kind of material, "wood metal." This must be clarified.

b. Regarding Claim 8, the phrase "and combinations thereof" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and combinations thereof"), thereby rendering the scope of the claim(s) unascertainable.

c. Regarding Claim 10, the phrase "and combinations thereof" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and combinations thereof"), thereby rendering the scope of the claim(s) unascertainable. Further, it is unclear how the attachment devices recited in the instant claim could be used to rotably attach two shelf segments.

d. Regarding Claim 14, the phrase "further comprising a pair of passages at a first side of the shelf and a second pair of passages at a second end side of the shelf" renders the claim indefinite. This embodiment of the invention has not been disclosed or presented in the specification to a sufficient degree.

e. Regarding Claim 15, the phrase "and combinations thereof" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and combinations thereof"), thereby rendering the scope of the claim(s) unascertainable.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 11, 13, and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

f. Regarding Claim 6, the limitation "at least one attachment device" renders the claim indefinite. An attachment device is already claimed in claim 1, which is a parent to the instant claim. It is unclear if the attachment device of claim 6 is the same as that of claim 1 or a separate device. The applicant must use terminology to differentiate between separate elements of the claimed invention.

g. Regarding Claim 11, as stated above in the discussion of Claim 6, the applicant has disclosed multiple attachment devices in parent claims 6 and 1. The limitation in the instant claim of "at least one passage in the shelf for the attachment device to pass" renders the claim indefinite. Because there are multiple attachment devices apparently serving different purposes, it is unclear which device the "passage" of the instant claim interacts with and how it does so. Further, the applicant recites that the passage is for the "attachment device to pass." It is unclear if the applicant intends for the device to pass next to the passage or through the passage.

h. Regarding Claim 13, the limitation "at least two attachment devices" renders the claim indefinite. Because the element of an "attachment device" has occurred at two points in parent claims (claims 1 and 6), it is unclear whether the attachment devices of the instant claim are the same as those previously claimed or if the applicant intends to claim new attachment devices. Further, it is unclear

how the attachment devices recited in the instant claim could be used to rotably attach two shelf segments.

i. Regarding Claim 14, the recitation of a second set (to make a pair at each end) of passages is unclear. The relationship between the passages and attachment devices has not been established (see above), and the addition of a second set of passages further complicates the claim: is it unclear what function the second set of passages serves. As currently claimed, any second set of passages at respective end sides of a holder, regardless of their function, would suffice as a prior art teaching.

j. Regarding Claim 16, the phrase "at least one accessory mounted on said shelf" renders the claim indefinite. It is unclear what the applicant intends this element to be or how the element relates to the rest of the claimed subject matter.

k. Regarding Claim 17, the phrase "at least one" renders the claim indefinite. It is unclear what the applicant intends this element to be.

l. Regarding Claim 18, the phrases "to the steering wheel of the vehicle," "reading material," and "leaning the reading material against the steering wheel" render the claim indefinite. The applicant discloses a "method of reading in a vehicle" then goes on to recite elements of the car and reading material. It is unclear if the applicant intends to claim the method of reading in a vehicle or the elements recited in the claim. Further, a "method of reading" by its very nature should include the step of reading, which the claim omits.

m. Regarding Claim 19, the phrase "passing an attachment device through a passage" renders the claim indefinite. Because multiple attachments devices have been recited in the parent claims, it is unclear which of the attachment devices the applicant intends to pass through the passage. Further, it is unclear how a user would be able to "wrap" a clip or a clamp (two of the options for the attachment device) around a steering wheel.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

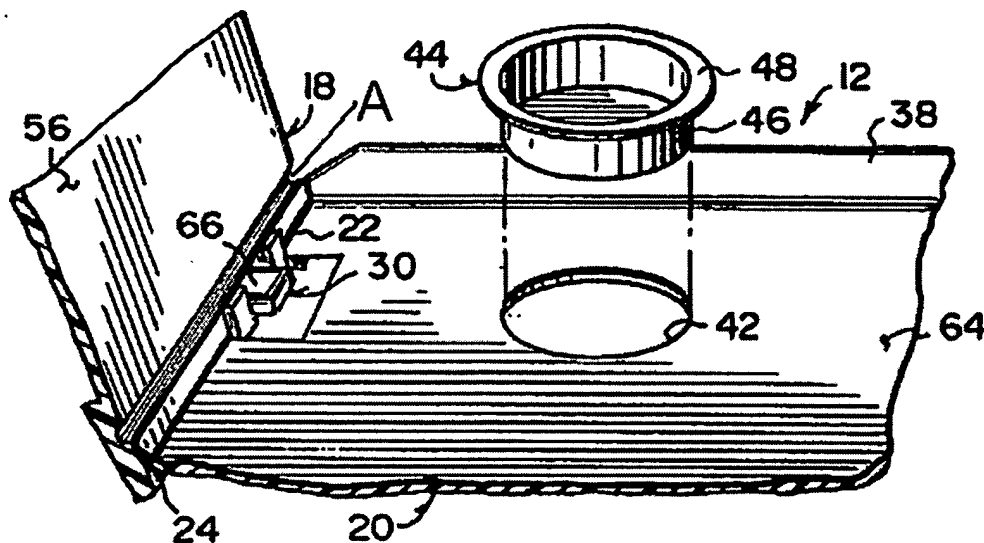
7. Claims 1-6, 8, 10, 12, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernandez in US Patent 5413035.

n. Regarding Claim 1, Fernandez discloses a periodical holder for a vehicle comprising a shelf (64) and at least one attachment device (26) for removably attaching the shelf to the steering wheel of a vehicle.

o. Regarding Claim 2, Fernandez discloses that the shelf comprises at least two shelf segments (56, 64, 80).

p. Regarding Claim 3, Fernandez discloses that the shelf segments telescope (insofar as 80 extends from 64) and that there are a plurality of stops (the ends of slot 76 are considered "stops") on the shelf segments.

- q. Regarding Claim 4, Fernandez discloses that there is a channel (A) in the shelf.



Fernandez, Figure 4

- r. Regarding Claim 5, Fernandez discloses that there is a hinge (66) connecting two shelf segments (56, 64) which folds for compact storage (best seen in Callahan, Figure 5).
- s. Regarding Claim 6, Fernandez discloses at least one attachment device (30) for rotably attaching at least two shelf segments (56, 64).
- t. Regarding Claims 8 and 10, Fernandez discloses that the attachment device (26) is a clip.



- u. Regarding Claim 12, Fernandez discloses that the shelf has an adjustable length (the extension of shelf segment 80 from shelf segment 64 is considered an “adjustable length” shelf).
  - v. Regarding Claim 15, Fernandez discloses that the shelf (segment 56) has a curved contour (36).
  - w. Regarding Claims 16 and 17, Fernandez discloses that the holder further comprises an aperture (42) and at least one accessory (44) mounted on the shelf, the accessory having a projecting member (46) that mates with the aperture to mount the accessory to the shelf.
8. Claims 1, 2, 4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Callahan in US Patent 5487521.
- x. Regarding Claim 1, Callahan discloses a periodical holder for a vehicle comprising a shelf (10, 12) and at least one attachment device (13) for removably attaching the shelf to a steering wheel of the vehicle.
  - y. Regarding Claim 2, Callahan further discloses that the shelf comprises at least two (10, 12) shelf segments.
  - z. Regarding Claim 4, Callahan further discloses that the device further comprises a channel (14) in the shelf.
  - aa. Regarding Claim 7, Callahan further discloses that the shelf is made from plastic or metal (see Callahan, Column 3, lines 21-22).
  - bb. Regarding Claim 8, Callahan further discloses that the attachment device (13) is a clip.

9. Claims 1, 2, 4-11 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Malinski in US Patent 5060581.

cc. Regarding Claim 1, Malinski discloses a periodical holder for a vehicle comprising a shelf (1, 3) and an attachment device (11) for removably attaching the shelf to a steering wheel of the vehicle.

dd. Regarding Claim 2, Malinski discloses that the shelf comprises at least two segments (1, 3).

ee. Regarding Claim 4, Malinski discloses that the shelf further comprises a channel (21).

ff. Regarding Claim 5, Malinski discloses that the shelf comprises at least one hinge (5) connecting two shelf segments (1, 3)

gg. Regarding Claim 6, Malinski discloses that the periodical holder further comprises at least one attachment device (5) for rotably attaching the two shelf segments (1, 3).

hh. Regarding Claim 7, Malinski discloses that the shelf is made of plastic (see Malinski, Column 6, lines 29-30).

ii. Regarding Claims 8 and 10, Malinski discloses that the attachment device (11) is a cable.

jj. Regarding Claims 9 and 11, Malinski discloses that there is a passage (12a) in the shelf for the attachment device to pass.

kk. Regarding Claims 18-20, Malinski discloses a method of reading comprising the steps of expanding the shelf of the periodical holder of Claim 10,

passing an attachment device through a passage in the shelf, attaching the holder to the steering wheel of a vehicle by wrapping the attachment device around the steering wheel and securing the shelf to the steering wheel, placing reading material on the shelf (see Malinski, Column 6, line 16-19) and leaning the reading material on the steering wheel (see Malinski, Column 8, lines 46-49).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malinski as applied to Claim 11 above in view of Dobbs in US Patent 2518127.

II. Regarding Claim 13, as stated above, Malinski discloses all of the limitations of Claim 11 including a periodical holder with an attachment device. Malinski further discloses that the holder comprises at least two passages (12a and 12b) at respective first and second end sides of the shelf but fails to disclose two attachment devices or that the attachment devices are hook and loop fasteners or elasticomeric straps. Dobbs teaches a shelf device having two attachment devices (15) that are elasticomeric straps (see Dobbs, column 2, line 50-51). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Malinski by using two elasticomeric strap

attachment devices as taught by Dobbs in order to more securely attach the shelf device to the steering wheel and to allow the device to flex under the weight of the contents of the shelf instead of simply breaking.

mm. Regarding Claim 14, as stated above, Malinski in view of Dobbs teaches all of the limitations of Claim 13. Malinski further teaches that the holder further comprises a first pair of passages (12a and 14a) at a first end side of the shelf and a second pair of passages (12b and 14b) at a second end side of the shelf.

Note: the relationship between the recited passages and the recited attachment devices of the instant claim is unclear.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jacovelli, Dobbs, Lee, Chen, Seibert and Lendl disclose folding trays. Mullaney discloses a clamp means to attach a tray to a steering wheel. Perlswieg discloses an elastomeric means to attach a device to a steering wheel. Jaykus discloses an expanding shelf.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/28/06

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